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In re Application of: Yates, et al.)
Application No. 09/385,394) DECISION ON PETITION FOR
Attorney Docket No. 114596-03-4000) SUPERVISORY REVIEW
Filed: 08/30/1999) UNDER 37 CFR §1.181
For: COMPUTER WITH TWO)
EXECUTION MODES)

This is a decision on the petition under 37 CFR § 1.181, originally filed April 8, 2005, and supplemented on June 14, 2005 and June 17, 2005, requesting the Commissioner to invoke his supervisory authority and withdraw the finality of the Final Office action mailed October 25, 2004 and to enter the amendment under 37 C.F.R. 1.116 filed on April 14, 2005 (copy filed April 18, 2005). The instant petition(s) also requests Examiner consideration of a reference cited on form 1449, filed July 15, 2004.

The petition is **GRANTED-in-PART**, to the extent indicated below.

RECENT PROSECUTION HISTORY

- (1) On February 9, 2004, a petition requesting reconsideration of the petition decision of December 4, 2003 was filed.
- (2) On February 11, 2004, a Non-Final Office action, treating all pending claims, was mailed. In addition, a copy of a Examiner considered references on form PTO-1449 was attached.
- (3) On May 4, 2004, a petition decision was mailed, denying Petitioner's request for reconsideration of the decision to dismiss a request for withdrawal of the Finality of a previous Office action. In the petition decision, it was noted that a proper request for continued examination (RCE) had been filed by Applicant on July 3, 2003.
- (4) On July 15, 2004, an amendment, response, two-month extension of time and IDS was filed by Applicant.
- (5) On October 25, 2004, a Final Office action, treating all pending claims, was mailed.

- (6) On January 25, 2005, a response was filed including: an amendment after Final rejection under 37 CFR 1.116; I.D.S.; as well as a request for reconsideration and request to withdraw the Finality of the October 25, 2004 Office action.
- (7) On February 14, 2005, an Advisory Action was mailed, indicating that the proposed amendment(s) would not be entered as they raised new issues that would require further consideration and/or search. The action also indicated that all references cited had been considered on attached (or previously provided) form(s) PTO-1449, with the exception of the reference to Kelly (WO 99/08188).
- (8) On April 8, 2005, a Petition under 37 CFR 1.181 requesting the Commissioner to invoke his supervisory authority and withdraw the finality of the Final Office action mailed October 25, 2004, to enter the amendment under 37 C.F.R. 1.116 and to consider the reference(s) cited on form 1449 was filed.
- (9) On April 14, 2005, a response, exhibit, an amendment, a three month extension of time, and copy of IDS (previously filed) was filed.
- (10) On April 18, 2005, a request to withdraw the Finality, duplicate copy of response and amendment, and IDS was filed.
- (11) On April 28, 2005, a Notice of Appeal, response and (apparently different) amendment under 37 CFR 1.116 was filed.
- (12) On June 7, 2005, an Advisory Action treating proposed amendments filed April 14, 18 & 28, 2005 was mailed, indicating that the proposed amendment(s) would not be entered as they raise new issues that would require further consideration and/or search. The action also included a copy of non-considered PTO-1449. The Advisory Action also recognized that the submission of April 8, 2005 was in fact a petition to withdraw the finality of the action mailed October 25, 2005, and forwarded such submission to the appropriate deciding officials.
- (13) On June 14, 2005, in response to the Advisory Action, a supplemental petition (to the original petition filed April 8, 2005) was filed.
- (14) On June 17, 2005, an additional supplemental petition was filed. Petitioner acknowledges that all references cited have been considered by the Examiner with the exception of Kelly (WO 99/08188) noted above.

RELIEF REQUESTED

The instant petition filed under 37 CFR 1.181 requests the following relief: A) withdrawal of the finality of the October 25, 2004 office action as prosecution was alleged to have been prematurely closed; B) entry of the amendment filed April 14, 2005 under 37 CFR 1.116 (duplicate copy filed April 18, 2005); and C) Examiner consideration of the reference to Kelly (WO 99/08188) filed in an IDS (PTO form 1449) on July 15, 2004.

REQUIREMENTS

A petition under 37 CFR §1.181 must include: (1) a statement of facts involved and (2) the point or points to be reviewed and the action requested. Note, the mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. In addition § 1.181(f) sets forth: any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. Further, when a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, ... it may be required that there have been a proper request for reconsideration (37 CFR §1.111) and a repeated action by the examiner.

The petition initially filed on April 8, 2005 (and supplemented on June 14 & 17, 2005) includes elements (1) and (2) above. The petition was filed within two months of the action (Advisory Action, mailed February 14, 2005) from which the relief is requested i.e. the Examiner maintaining his position in response to the request for reconsideration (of the propriety of the final rejection of October 25, 2004).

OPINION

A) The request for Withdrawal of the Finality of the Office action mailed October 25, 2004 will be addressed first.

Petitioner presents the following arguments in support of the position that the Final rejection was premature:

In consideration of unamended claim 87, does the Final Office action of October 25, 2004 support closing of prosecution, i.e. no new grounds of rejection, see *In re Kronig* and *In re Wiechart*.

Does the Final Office action of October 25, 2004 timely comply with 37 CFR §1.113 for final rejection of unamended claim 22, i.e. no new grounds of rejection.

Under the definition for “new grounds of rejection” by the Federal Circuit and Board definitions, the new grounds of rejection of claims 104* and 87 were not necessitated by amendment.

In addition, Petitioner argues that since a reference, submitted on form PTO-1449 has not been considered, (i.e. WO 99/08188 to Kelly), “present procedures” for examination of the application were not completed and therefore closing of prosecution is premature.

ANALYSIS

The relevant section of the MPEP concerning finality of Office practice is MPEP § 706.07. The MPEP does discourage the shifting “from one set of references to another in rejecting in successive actions claims of substantially the same subject matter. However, contrary to Petitioner’s assertion, clear issues have been developed. In the language of the MPEP:

*Note, claim 104 was first identified in the request for reconsideration filed on January 25, 2005 and then again in the supplemental petitions of June 14 & June 17, 2005, but not in the original petition filed on April 8, 2005.

While the rules no longer give to an applicant the right to “amend as often as the examiner presents new references or reasons for rejection,” present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. ***But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.***

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits.

Neither the statutes nor the Rules of Practice confer any right on an applicant to an extended prosecution; Ex parte Hoogendam, 1939 C.D. 3, 499 O.G.3, 40 USPQ 389 (Comm'r Pat. 1939).

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, ***where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's reply.*** If appeal is taken in such a case, the examiner's answer should contain a complete statement of the examiner's position.

Finally, as set forth in MPEP 706.07(a):

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). (emphasis added)

It is noted that numerous communications after Final rejection have been filed in the instant application, including some apparent duplicate or refiled communications restating issues that had been previously presented by Applicant. Such numerous filings confuse the prosecution history of the instant application.

With respect to the petition at hand, in the instant application, with respect to claims 22, 87 and 104, a comparison of the Non-Final Office action of February 11, 2004 with the Final Office action of October 25, 2004 reveals that the Examiner maintained the same statutory basis of rejection for each of claims 22, 87 and 104. That is, claim 104 was rejected in both actions under 35 USC 102(e) as being clearly anticipated by Goetz et al. (US 5,854,913) and claims 22 and 87 were each rejected in both actions under 35 USC 103(a) as being obvious over Goetz et al. (US 5,854,913) in view of Brender et al. (US 5,339,422) and Murphy et al. (US 5,764,947).

First, Petitioner should be advised that there is no requirement that an element for element or limitation for limitation identification (between the claims and reference(s) be provided to applicant in the grounds of rejection set forth in the examination process, particularly in a rejection wherein the identification of the claimed limitations are readily apparent. Second, upon careful reading of both the Non-Final Office action of February 11, 2004 and the Final Office action of October 25, 2004, it is apparent that the Examiner has fully developed a position on the above identified claims in these Office actions. Further, the position taken by the Examiner has been presented to Applicant in multiple Office communications including the Final rejection. Specifically, with respect to each of claims 104, 22, 87, the Examiner's rejection of these claims is identified clearly in the Non-Final Office action at paragraphs 10 and 46, respectively. In applicant's response filed July 15, 2004, in which these claims were not amended but separately argued that the applied references do not teach a feature of the claim(s), the Examiner responded directly (in the Final rejection of October 25, 2005) to Applicant's arguments by pointing out where the argued feature was taught.

Contrary to the citations of case law presented by Petitioner, it cannot be seen how further clarifying ones position and responding directly to limitations identified as "not taught by the cited art" could be construed to be "a new line of reasoning" (*In re Kronig*) or "relying on a new portion of a reference" (*In re Wiechert*). The rejections presented and explanations provided by the Examiner are not read in a vacuum, but rather with an understanding and knowledge of one having "ordinary skill in the art" (MPEP 2106).

The Examiner clearly identifies the specific elements in the applied art which are being relied upon to meet the claim limitations. Furthermore, Applicant's response to the rejections and the arguments presented in this petition delineate issues which have been clearly developed between the Examiner and Applicant. The Examiner has explained his position in detail in the Non-Final action. Applicant has traversed and the Examiner has correspondingly responded to each traversal in a timely manner, addressing all points raised by Applicant in even greater detail in the Final Office action. Differences of opinion are not unexpected in regular examination processes. It is apparent that these issues are now ripe for appeal.

The Examiner's holding of Finality with respect to the rejections of record in the Final Office action mailed October 25, 2004 is correct and in accordance with Office policy and practice. Accordingly the petition to withdraw the finality is **DISMISSED**.

Thus, Petitioner's assertion that "because present practice was not observed in the Office action of October 2004, MPEP § 706.07(a) does not authorize closure of prosecution", finds no merit since MPEP § 706.07(a), as it relates to 37 CFR § 1.97, is based upon the introduction of an improper "new grounds of rejection". Since no "new grounds of rejection" is present in the Final Office action (as discussed above), and since consideration of a reference cited in an information disclosure statement is not a controlling factor as to whether an Office action can or cannot be made final, closing of prosecution in the Final Office action of October 25, 2004 is deemed to be proper.

B) The propriety of the Examiner's refusal to enter the amendment after final will now be addressed.

In the response filed April 14, 2005, Applicant indicates that since the finality of the Office action of October 25, 2004 was premature, that "the amendments proposed here may be entered as a matter of right. Even if finality is maintained, these amendments are entitled to entry under Rule 116".

The relevant section of the MPEP concerning entry of amendments after final rejection is MPEP § 714.13 which states:

ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims. Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(c) is expected in all amendments after final rejection.

Newly amended claim 63, as proposed, is not equivalent to a previously presented claim, but rather it presents a combination of limitations not previously presented. This change in scope of the claim limitations requires more than a cursory review, as indicated in the Advisory Action mailed June 7, 2005. In addition, it is noted that the proposed amendment of April 14, 2005 presents additional claims (proposed claims 134 & 135) without canceling a corresponding number of finally rejected claims.

Therefore, the Examiner's refusal to enter the proposed amendment filed in Paper No. 14 is correct and consistent with Office policy and practice. Accordingly, the petition to compel the examiner to enter the amendment is **DISMISSED**.

C) The propriety of the Examiner's refusal to consider the reference cited in the IDS, filed on July 15, 2004 will now be addressed.

The relevant section of the MPEP concerning consideration of references filed is found in MPEP § 609 and 37 CFR §§ 1.97, 1.98:

37 CFR 1.97. Filing of information disclosure statement.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

- (1) The statement specified in paragraph (e) of this section; or
- (2) **The fee set forth in § 1.17(p).**

37 CFR 1.98. Content of information disclosure statement.

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, **unless:**

- (1) **The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and**
- (2) **The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.**

A review of the file history indicates that the IDS filed July 15, 2004, which lists the Kelly WO 99/08188 reference, includes a fee payment of \$180.00 received by check on July 16, 2004 as per 37 CFR 1.97(c)(2). Further, a copy of the Kelly reference is found in the earlier filed US application SN 09/239,194 to which the instant application directly relies upon for an earlier effective filing date under 35 U.S.C. § 120 (instant application is a continuation-in-part of the earlier application, as referenced on page 1 line 5 of the instant specification). Since the Kelly reference was properly cited and considered in the earlier application, it is found to comply with 37 CFR 1.98(d)(1)(2) and thus entitled to consideration in the instant application.

Since present Office practice with respect to consideration of references properly cited was not followed, accordingly, the petition to compel the Examiner to consider the reference is **GRANTED**.

CONCLUSION

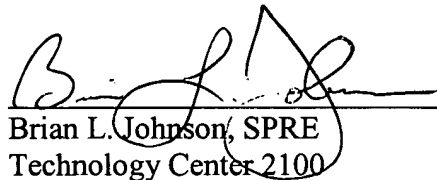
For the above stated reasons, the petition to withdraw the finality of the final Office action of October 25, 2004 is **DISMISSED**.

For the above stated reasons, the petition to enter the amendment filed after final rejection under 37 CFR §1.116 is **DISMISSED**.

The petition for Examiner consideration of the reference to Kelly (WO 99/08188) is **GRANTED**. The Examiner is directed to consider the reference as cited on form PTO-1449 filed on July 15, 2004 (note, copy present in related application SN 09/239,194).

The application is being forwarded to the examiner for consideration of the reference to Kelly (WO 99/08188). Appellant is reminded that the Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

Any inquiries related to this decision may be directed to Specials Program Examiner Brian Johnson at (571) 272-3595.



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